

Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

LAMB-001/00US

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Application Number

10/000,094

Filed

12/4/01

First Named Inventor

Kurt R. Dahlberg

Art Unit

3643

Examiner

Son T. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 40,420
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Erich E. Veitenheimer
Signature

Erich E. Veitenheimer
Typed or printed name

202-842-7801
Telephone number

January 6, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kurt R. Dahlberg *et al.*

Examiner: Son T. Nguyen

Serial No.: 10/000,094

Art Unit: 3643

Filed: December 4, 2001

Confirmation No.: 8029

For: **POLYSACCHARIDE MUSHROOM COMPOST SUPPLEMENTS**

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ARGUMENTS IN SUPPORT OF PRE-APPEAL REQUEST FOR REVIEW

Applicants submit the following statements regarding two issues which are under consideration in the Pre-Appeal Brief Request for Review filed herewith.

Issue No. 1. Claims 1-7 and 36 stand rejected under 35 U.S.C. § 102 as purportedly being anticipated by Romaine *et al.* (U.S. Patent No. 4,803,800; hereinafter referred to as “the Romaine patent”); and claims 8-16 and 18-35 under 35 U.S.C. § 103 as purportedly being unpatentable over the same reference.

Claim 1 directed to a composition will be the primary focus of the arguments stated herein since composition claims 2-16, 18-27 and 36 depend either directly or indirectly from claim 1, while claims 28-35 are directed to methods that require the use of the composition claimed in claim 1. The arguments provided herein are meant to apply equally to all of the pending claims and collectively to all of the outstanding rejections of those claims.

Independent claim 1 is as follows:

1. An enriched mushroom compost supplement, wherein the enrichment comprises the addition of a polysaccharide or polysaccharide composition to a mushroom compost supplement, wherein the enriched mushroom compost supplement does not comprise mushroom mycelia.

Thus, this claim is directed to an improved (i.e., “enriched”) “mushroom compost supplement”. In the as-filed specification at page 12, lines 1-4, this term is clearly defined as “a nutrient material or mixture of nutrient materials that is added to mushroom compost”.

In the as-filed specification at page 11, lines 29-31, a “mushroom compost” is clearly defined as “the nutritive substrate contained within . . . a mushroom bed”, wherein this substrate “does not include the casing layer”.

In the as-filed specification at page 11, lines 18-19, a “casing layer” is clearly defined as “a top dressing . . . which is placed over the mushroom compost”.

Despite Applicants’ reliance on these art-recognized meanings of terms associated with mushroom culture, the Examiner continues to reject claim 1 (and the other pending claims which directly or ultimately depend from claim 1) over the Romaine patent, particularly claim 2 of the Romaine patent. Applicants had provided the Examiner with a Declaration Under 37 C.F.R. 132 by Dr. Romaine (“the Romaine Declaration”) in which Romaine states that he is “the principle inventor of U.S. Patent No. 4,803,800” (§ 5, page 2) and wherein he provides detailed explanations of the scientific and art-recognized reasons as to why the Romaine patent fails to anticipate or render obvious the claims of the instant application. See, the Romaine Declaration, §§ 5-11, pages 2-4. Dr. Romaine’s 43 page “Curriculum Vitae” attached to the Declaration as Exhibit A clearly establishes that he is a prominent expert in mushrooms and mushroom cultivation.

Although the Examiner states in the Advisory Action that “the Examiner has acknowledged the Romaine Declaration”, she summarily dismissed the Romaine Declaration by stating that “the Declaration cannot be employed to overcome a rejection under 102(b)” (Final Office Action, § 5, page 6). As stated in Applicants’ Amendment Under 37 C.F.R. § 1.116 at pages 9-10, Applicants’ Representative cannot find any statutory or regulatory basis whatsoever for the Examiner’s decision to so quickly and lightly dismiss the pertinence of the Romaine Declaration to the rejection being maintained under 35 U.S.C. § 102(b). The panel members are respectfully requested to review the Examiner’s position that the Romaine Declaration is not pertinent to the current pending rejections over the Romaine patent. If the rejection is maintained, then the panel members are respectfully requested to provide the basis upon which such a decision is based so that the record is clear for the subsequent appeal process.

Dr. Romaine also points out to the Examiner “several errors and erroneous assumptions” in the Office Action dated October 25, 2004, which highlight the Examiner’s failure to understand the terminology associated with the art of mushroom culture. See, the Romaine

Declaration, ¶ 12, A-H, pages 4-7. In particular, the panel members are urged to review ¶ 12, B, pages 4-5, of the Romaine Declaration which addresses the reasons why claim 2 of the Romaine patent does not anticipate or render obvious the claims of the instant application. Claim 2 of the Romaine patent is the very claim relied upon by the Examiner in her Advisory Action as supporting her assertion that the pending claims are anticipated or obvious.

As stated at pages 9-11 of Applicants' Amendment Under 37 C.F.R. § 1.116, filed on November 7, 2005, Applicants' Representative believes that it is not proper for the Examiner to completely ignore the arguments provided in the Romaine Declaration when evaluating the presently pending claims in view of the Romaine patent. Applicants therefore respectfully request that the panel members review the Examiner's position in the view of the record, including Applicants' previously-filed arguments and the Romaine Declaration.

Issue No. 2. In the Advisory Action mailed November 22, 2005, the Examiner states the following (see, Continuation of 11):

"Furthermore, Applicant failed to respond to the Examiner's comment regarding Mr. Frank Parker's letter faxed to the Office on 5/25/05 and 5/31/05, which in the letter, Mr. Parker stated that polysaccharide is old and well known in the art to be used as a nutrient. Therefore, even if the Romaine reference is overcome, which it is not, other references provided by Mr. Parker teach using polysaccharide as a nutrient."

We note for the record that Applicants believe that the Examiner meant to refer to Mr. Parker's letters of 11/13/04 and 5/25/05. Perhaps the misunderstanding arose because there are two copies of the 5/25/05 letter in the Image File Wrapper. One was logged on 5/25/05 and the other one on 5/31/05.

The "Examiner's comment" referred to in the above recitation is as follows (Final Office Action, page 6, ¶ 5):

"In addition, it is noted that the letters mailed on 10/14/04 & 5/31/05 by Mr. Frank Parker contain prior art US 5186731 & US 3942969 which teach the same ingredients as claimed by the present invention."

As an initial matter, the Examiner failed to reject any pending claim over either of the references provided by Mr. Parker. Therefore, no response by Applicants was necessary or appropriate. Secondly, the "Examiner's comment" did not ask for Applicants' response. Thirdly, these patents are readily available to the Examiner if a rejection is warranted. In fact,

Applicants had already cited U.S. Patent No. 3,942,969 (“the ‘969 patent”) with the Information Disclosure Statement filed on July 2, 2002 – well before the Examiner issued the first Non-Final Office Action. The Examiner had indicated by her signature and initials that she had already considered this patent. In addition, the ‘969 patent is discussed in ¶ 0013 at pages 4-5 of the as-filed specification. The other patent discussed by Mr. Parker is U.S. Patent No. 5,186,731 (“the ‘731 patent”). Since the Examiner was made aware of this patent by Mr. Parker, then she should have cited it in a proper rejection if she thought it was applicable. It is not Applicants’ obligation to do the Examiner’s official governmental duties for her.

For many of the reasons stated on the record in response to the rejections actually made in this application, Applicants do not believe that either the ‘696 patent or the ‘731 patent alone or together anticipate or render obvious the pending claims in the instant application. It is the Examiner’s responsibility and job to reopen prosecution and reject the pending claims over one or both of these patents if she believes they are applicable.

However, even Mr. Parker acknowledges the inventive aspects of the presently pending claims. Importantly, in his letter of May 25, 2005, Mr. Parker states that “starch is conducive to heat surge and is a catalyst for mushroom disease” and that “it is also very difficult to protect from microbial attack”. Applicants could not agree with this statement more and at the outset had already clearly stated that these two well-known, art-recognized, undesirable effects were of paramount importance in conducting the research that led to their presently-claimed invention. See, ¶ 0012 at page 4 of the as-filed specification. In fact, Mr. Parker’s stated concerns are the very unexpected results accomplished by the present invention as stated at ¶ 0021 on page 7 (underlining, bolding added):

“There is currently an unmet need in the art of mushroom cultivation, which is satisfied by the instant invention, for a mushroom compost supplement that is able to further increase mushroom yields in an economic and cost-effective manner. The mushroom compost supplements of the present invention are based primarily on the unexpected finding that mushroom compost supplements with added polysaccharide such as, for example cellulose, increase mushroom yield without deleterious temperature surges or growth of foreign organisms during mushroom cultivation.”

Apparently, Mr. Parker also agrees that Applicants' invention provided unexpected results for a long-felt need in the mushroom cultivation arts. The Examiner does not appear to have taken this under consideration in making and maintaining the rejections, choosing instead to inappropriately put the burden on Applicants to establish reasons why non-applied art might be pertinent to the claimed invention.

Even Dr. Romaine stated that prior to the instant invention it "was previously unknown in the mushroom industry" that "the addition of polysaccharides like cellulose to the mushroom growing substrate results in significantly increased mushroom yields" (Romaine Declaration, page 4, ¶ 12).

Clearly, the record establishes that the unexpected results provided by the present invention have overcome the very problems needed to be solved in the industry as succinctly stated by the Applicants and Mr. Parker. Applicants and Applicants' Representative fail to understand how the Examiner can maintain the rejections of the pending claims over the Romaine patent in view of the strong record of evidence otherwise. The panel members are respectfully requested to carefully consider the complete record of this application when evaluating the Examiner's rejections.

CONCLUSION

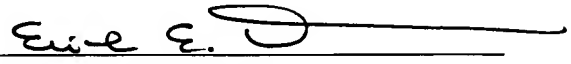
For the foregoing reasons, the Applicants respectfully requests the panel members review the Final Office Action and the Advisory Action and issue a decision that the pending claims are allowed.

Dated: January 6, 2006

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Respectfully submitted,
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